

### III. REMARKS

#### Status of the Claims

Claims 1,4-6,13 and 20 are amended and claims 2 and 3 are Cancelled. Claims 1, and 4-20 remain under consideration.

#### Summary of the Office Action

Claims 1,2 and 6 stand rejected under 35USC103(a) on the basis of the cited reference Swanchara et al, U.S. Patent No. 6,108,542 in view of the reference Mazur et al, U.S. Patent No. 6,463,054 and further in view of the reference Takayama, U.S. Patent No. 6,119,024. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

In rejecting the claims, the examiner has cited, for the first time, the references Swanchara, Mazur, and Takayama as a basis for the obviousness rejections. The citation of these new references was not necessitated by Applicant's prior amendments and accordingly the issuing of a final rejection is improper under MPEP section 706.07(c) where it is stated:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the

cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments. The entering of the above amendments will permit the clarification of the issues for appeal or the allowance of the claims.

#### Discussion of the Cited References

With respect to the claims as amended, the Examiner relies primarily on the reference Takayama to support the rejection based on obviousness.

The amended claims require the defining of at least two different paging periods and performing a selection between the defined paging periods on the basis of the received signal strength.

The mechanism that Takayama uses to reduce power consumption in a mobile station (MS) is different from that presented in the present application. In the sections to which the Examiner refers, Takayama teaches that the MS selects a standby paging channel (PCH) having an intermittent reception interval closest to and more than a desired interval and reports the selected PCH to the base station, as per col 2, lines 49 to 53.

"The mobile station selects, as a standby PCH, a PCH having an intermittent reception interval the closest to and less than a desired interval. The mobile station reports the selected standby PCH to the base station."

The mechanism is different, because in Takayama the MS, PCH is selected according to a desired interval.

The Examiner characterizes the disclosure of the reference Swanchara, at column 17, line 60 to column 18, line 2, as teaching the selection of a paging period on the basis of received signal strength. This is not supported by the cited reference. Swanchara indicates that a control channel may be selected based on signal strength or average signal strength. It does not disclose the selection of a paging period based on received signal strength.

The examiner also indicates, with respect to claim 3, that the reference Takayama teaches selection of a paging band signal strength. Applicant does not understand this reference as there is nothing in the cited reference that supports the statement.

In the paragraph relating to claim 4, the Examiner appears to have confused the reference to Swanchara with Takayama and visa versa. The Examiner states that Swanchara teaches the selection of band based upon time period, whereas in the case of claim 2 he states that this is taught by Takayama. Further, he states that Takayama discloses the selection of a paging band signal strength. Nevertheless

the above comments by applicant apply with respect to the teachings of the respective references.

Takayama does not disclose the selection of PCH according to signal strength, nor does he teach that this mechanism could be used. In the section referred to by the Examiner, using or determining signal strength is not disclosed in any form. As to the teachings of Swanchara, the section to which the Examiner refers does not disclose, selection of a band on the basis of a time period.

Takayama teaches the selection of the PCH according to desired paging period, as stated by the Examiner. Swanchara teaches the scanning of all relevant AMPS channels, as well as PCS channels (col. 18, lines 31 to 35). Thus in the section to which the Examiner refers, Swanchara teaches the scanning of all the channels in order to scan for better control channel (col. 10, lines 11 to 14). Swanchara does not disclose that the selection of the paging period is performed on the basis of signal strength.

Operations which are performed, when entering the idle mode, are disclosed in col. 12, line 31, to col. 13, line 16, in Swanchara. Further, col. 12, line 65, to col. 13, line 8, teaches means to estimate when the mobile station MS1 is predicted to register with the network. The system disclosed in Swanchara is based on the time of receiving the first registration ID message RMSG1 and the time of receiving the second registration ID message RMSG2.

Takayama does not teach the selection of the paging period according to signal strength, but instead selecting the PCH according to paging period. Swanchara teaches that if the MS operates in dual-network mode (AMPS/PCS in the case of Swanchara), the free time in PCS network can be used to scan for band in AMPS network with the best signal strength.

Applicant submits that, the comments of the Examiner may be based on hindsight, because neither of the cited documents teaches the selection of the paging period according to the signal strength. The motivation to examine signal strength in Swanchara is to determine the AMPS channel with the best signal quality during free time.

#### The Issue of Obviousness

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the reference Takayama, are not remedied by the proposed combination with the teaching of the reference Swanchara. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Takayama, Swanchara, and Mazur in order to obtain the invention, as described in the claims submitted

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herein, would not have been obvious to one skilled in the art. The cited reference either individually or in combination fail to disclose the selection of a paging period based on received signal strength.

The above remarks apply equally to the rejections as applied to all of the claims.


SUMMARY

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge Deposit Account No. 16-1350 for the amount of \$450.00 for a two (2) month extension of time.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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16 May 2005  
Date

## CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to 703-872-9306 on the date indicated below, addressed to the Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 5/16/2005 Signature: Marg Mirm